

REMARKS

Applicant gratefully acknowledges the Examiner's consideration in allowing claims 1-9 and 11-16.

Claim 21 is rejected under 35 U.S.C. 102(a) as being anticipated by *Dayan et al.* (U.S. 6,009,486). Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by *Croft et al.* (U.S. 5,864,708). These rejections are respectfully traversed on the grounds that the cited references are defective in supporting a rejection under 35 U.S.C. §102.

The PTO provides in MPEP §2131... "To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Dayan et al.* and *Croft et al.* patents must contain all of the claimed elements of claims 21 and 22. Claims 21 and 22 are amended to depend from an allowed claim and are therefore submitted to be allowable and not anticipated by the cited art.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant further traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness. Claims 21 and 22 are amended to depend from an allowed claim and are therefore submitted to be allowable and not obvious in view of the cited art.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness...

In this context, 35 U.S.C. §103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of the claims are not met by the *Dayan et al.* and *Croft et al.* patents, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the Examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because *inter alia*, the Examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

In view of the above, it is respectfully submitted that claims 1-9, 11-19 and 21-22 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,


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